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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,180	06/22/2000	James Arthur Brewer	AUS000213US1	8202

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EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
2155	6

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,180

Applicant(s)

BREWER ET AL.

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-22 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Request for Reconsideration

1. This office action is in response to the amendment filed on 8/21/2003. Claims 1-22 are presented for further examination.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons : Congdon teaches a method in a network computer for diagnosing a problem comprising running diagnostic testing programs on a diagnostic adapter card coupled to the network computer. For example, PCI management card 200 is constructed or programmed with software running on it [see Figs. 1&2 and Col. 3, Lines 3-17 and Col. 3, Lines 37-43]. Condon further teaches reporting the results from running the diagnostic programs. For example, reporting errors or failures locally or remotely over a computer network [see Abstract and Col. 3, Lines 37-43]. In addition, Condon teaches analyzing the results from running the diagnostic programs to determine a cause of the problem. For example, the host computer ascertains the nature of failures or occurred events [see Col. 7, Line 66 - Col. 8, Line 10]. In summary, Congdon teaches a method and system of monitoring/tracking error and fault conditions and testing/diagnosing problems on the PCI bus and associated components in the computer network. Those problems are managed by evaluation for correct operation.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642F. 2d 413, 208 USPQ

871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown in the following section.

Therefore, the examiner asserts that the cited prior arts teach or suggest the subject matter broadly recited in independent claims. Claims 2-6, 8-10, 12-16 and 18-22 are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Claim 11 is objected as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, rejections for claims 1-10 and 12-22 are respectfully maintained.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5, 7-10, 13-15 and 17-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Congdon, U.S. Pat. No. 6,311,296.

Regarding claim 1, Congdon teaches a method in a network computer for diagnosing a problem comprising the steps of :

running diagnostic testing programs on a diagnostic adapter card coupled to the network computer (i.e., PCI management card 200 is constructed or programmed with software running on it) [see Figs. 1&2 and Col. 3, Lines 3-17 and Col. 3, Lines 37-43];

reporting the results from running the diagnostic programs (i.e., reporting errors or failures locally or remotely over a computer network) [see Abstract and Col. 3, Lines 37-43]; and

analyzing the results from running the diagnostic programs to determine a cause of the problem (i.e., the host computer ascertains the nature of failures or occurred events) [see Col. 7, Line 66 - Col. 8, Line 10].

Regarding claim 2, Congdon further teaches the method of claim 1, wherein the diagnostic adapter card is coupled to the network computer by way of an open slot on a PCI (Peripheral Component Interconnect) bus in the network computer (i.e., PCI management card 200 is coupled to the host 240 by the PCI bus 230) [see Fig. 2].

Regarding claim 3, Congdon further teaches the method of claim 1, wherein running diagnostic programs includes running a program to test one of bus timing, bus

mastering, direct memory access operations, data and control registers associated with devices connected to a system bus, system memory, timeout functions, a boot flash monitor, input/output integrity for one or more devices selected from a keyboard, a mouse, a graphics adapter, a serial port, a parallel port, a universal serial bus port, a microphone, a speaker, and an audio output port (i.e., executing a diagnostic program to test bus/host clock, to test a boot flash, to test memory and to test registers, to test I/O devices connected to the bus,...) [see Abstract and Col. 3, Lines 3-17 and Col. 5, Lines 25-67 and Col. 7, Lines 7-65 and Col. 9, Line 61 - Col. 10, Line 5].

Regarding claim 4, Congdon further teaches the method of claim 1, wherein reporting results includes one of sending data to a remote workstation, storing information in a log file, and displaying a result code on a display device connected to the diagnostic adapter card (i.e., failures or errors are reported to the remote host, events are logged or recorded, and results are displayed) [see Col. 3, Lines 32-49 and Col. 7, Line 66 - Col. 8, Line 55].

Regarding claim 5, Congdon further teaches the method of claim 1, wherein analyzing results includes one of detecting the absence of a response from a component, detecting a discrepancy between an expected response and an actual response, and recognizing errors in signal timing (i.e., detecting mismatched response time, irregular time, and timeout) [see Abstract and Col. 4, Lines 41-63 and Col. 7, Lines 33-52 and Col. 9, Line 61 - Col. 10, Line 5].

Claim 7 is rejected under the same rationale set forth above to claim 1.

Claim 8 is rejected under the same rationale set forth above to claim 2. In addition, Congdon further teaches one or more wrap cables (i.e., cable 12) [see Fig. 1].

Regarding claim 9, Congdon further teaches the diagnostic adapter card of claim 8, wherein the diagnostic adapter card includes a processing means to execute the diagnostic testing programs, a read only memory to boot the processing means, a random access memory to store diagnostic testing programs and data to be processed by the processing means, a first external connector to interface with a reporting device, and a second external connector to connect a wrap cable to send or receive sample data (i.e., PCI management card 200 includes processor 218, PCI bus controller 210, local network controller 220, local memory 216, ...) [see Figs. 1&2 and Col. 3, Line 3 - Col. 4, Line 23 and Col. 5, Line 59 - Col. 6, Line 7].

Regarding claim 10, Congdon further teaches the diagnostic adapter card of claim 8, wherein an integrity of a first input/output port in the network computer and a second input/output port in the network computer is tested by connecting a wrap cable between the first input/output port and the second input/output port (i.e., testing the integrity of connection) [see Col. 1, Line 36 - Col. 2, Line 1].

Claims 13-15 are rejected under the same rationale set forth above to claims 3-5.

Claim 17 is rejected under the same rationale set forth above to claim 7.

Claim 18 is rejected under the same rationale set forth above to claim 10.

Claims 19-21 are rejected under the same rationale set forth above to claims 13-15.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 6, 16 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Congdon, U.S. Pat. No. 6,311,296 in view of Pickreign et al (Hereafter, Pickreign), U.S. Pat. No. 6,539,338.

Regarding claim 6, Congdon further teaches the method of claim 1, wherein analysing the results from running the diagnostic testing programs includes one of detecting a nonfunctioning component and detecting an intermittently failing component (i.e., detecting when a PCI clock stopped operating and detecting a bus/host clock

which alternates at an irregular times,...) [see Col. 7, Lines 20-32 and Col. 9, Line 61 - Col. 10, Line 5]. Congdon does not explicitly teach detecting a faulty software program. However, the cause of problem including detection of a faulty program is old and well-known in the art as disclosed by Pickreign [see Col. 2, Lines 9-20]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to check the software in order to identify the possible errors caused by a faulty software coding.

Claims 16 and 22 are rejected under the same rationale set forth above to claim 6.

8. Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Congdon, U.S. Pat. No. 6,311,296 in view of Ellis et al (Hereafter, Ellis), U.S. Pat. No. 6,256,687.

Regarding claim 12, Congdon does not explicitly teach the diagnostic adapter card of claim 10, wherein the wrap cable between the first input/output port and the second input/output port converts a format of the data without changing content of the data. However, Ellis teaches managing data flow between a Universal Serial Bus (USB) port and a parallel port wherein data is converted into specific signal format supporting the types of ports such as serial-to-parallel or parallel-to-serial [see Col. 3, Lines 44-50 and Col. 15, Lines 12-30]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include Ellis's teaching of converting signal format without changing the content to support transferring of data between serial port and parallel port.

Allowable Subject Matter

9. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).


A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Philip Tran
Art Unit 2155
Oct 23, 2003


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER